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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,498	08/01/2001	Klein Rodrigues	1943.ALC	71-18

35157 7590 10/21/2003

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EXAMINER
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TARAZANO, DONALD LAWRENCE

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/920,498

Applicant(s)

RODRIGUES ET AL.

Examiner

D. Lawrence Tarazano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8-8-2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by "substantially no stabilizing surfactants", because these additives are generally used in very small amounts. It is not clear how much of these materials may be present.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-10 and 12- 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending

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Application No. 09/690,387. Although the conflicting claims are not identical, they are not patentably distinct from each other because the "hydrophilic" monomer of the instant application can be an acid monomer, which is neutralized with a base (claims 7-9). This corresponds to the "hydrophilic base-neutralizable" monomer cited in the first claim of the 09/690,387.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-10 and 12-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Diel et al. (6,337,379).

7. Diehl et al. teach a latex binder comprising hydrophobic monomers (styrene), hydrophilic acidic monomers (itaconic acid, acrylic acid), water, and a surfactant (column 3, lines 29+ and the example). The latex is neutralized with bases such as sodium hydroxide as claimed. The materials are applied to a fiber mat (a textile application) in which solids concentrations of 15-45% are used (column 3, lines 1+). The applicants state that their materials are not cross-linked.

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While the materials taught by Diehl et al. are cross-linked this is done after the materials are dried at a lower temperature (212 deg F) (example). The intermediate (un-cured) product would correspond to the claimed materials.

The applicants claim a number of physical properties such as clarity, solubility in basic or acid media etc... The examiner takes the position that the monomer used would yield clear base soluble materials based on the monomers used because they correspond to the types of materials used by the applicants in the instant application.

Regarding claim 16, the fiber web formed is used in personal hygiene products so the materials do get wet. In this instance, the web would be water-resistant, as it would resist falling apart when placed in contact with water.

While small amounts of surfactants are used, since such small amounts are used (as low as 0.05% (column 3, lines 41+), the materials are "substantially free of surfactants" as claimed.

8. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Schoenberg et al (6,150,468) with additional evidence provided by Westerman (6,488,764) if deemed necessary.

9. Schoenberg et al. teach emulsions comprising "star polymers" made from butyl acrylate (a hydrophobic monomer according to applicants' specification page 6) and acrylic monomers (a hydrophilic monomer). See Example III: The compositions comprise 10% solids, are clear and comprise: ethanol, which would function as an "anti-microbial agent" (claim 5) and sodium hydroxide.

10. The star polymer is also incorporated into a second composition (see column 7, lines 26+ and Examples 8 and 9), which is used as a laminating adhesive. See Westerman column 6, lines

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67+, which shows that the Aerosol <sup>TM</sup> material used in Examples VIII and IX is a surfactant as claimed.

11. Both the intermediate product (star polymer) and the final product (polymer composition comprising the star polymer) read on the applicants' composition.

12. Regarding claims 17-20, the materials taught are used as "coating" and "adhesives" which gives clear indication that the materials are used in multilayer structures, and they are used as sizes in "textile applications" (column 8, lines 46+). This is described with sufficient specificity to meet the applicants' claims directed to "coated articles" and "method of using the composition".

13. Claims 1-10, 12-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kneip et al. (6,200,640).

14. Kneip et al. teach polymeric dispersions used to tan leather (claims). The materials comprise a tanning agent (preservative) and are neutralized with a base such as sodium hydroxide (column 8, lines 41+). The solutions have solids contents within the preferred range of 20 to 60% (column 8, lines 58-60).

### ***Response to Arguments***

3. Applicant's arguments filed 8-8-2003 have been fully considered but they are not persuasive. The applicants have amended the claims to state that the compositions are "substantially free of surfactants", but and base their arguments on the fact that the compositions use surfactants and they do not. The examiner does not believe that the applicants' arguments are commensurate in scope with what is claimed. The claims state that the compositions are

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"substantially free", not "free" so small amounts of surfactants are permitted. In all instance the prior art uses very small amounts of surfactants so the compositions are in fact "substantially free" of surfactants. The term "substantially free" is subjective and the applicants have not fully defined it in a way to differentiate the claimed invention from the prior art.

4. The double patenting rejection has been repeated. The applicants did not argue the merits of the rejection; they stated that the issue will be held in abeyance until allowable subject matter is indicated. The other application is still pending.

### *Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

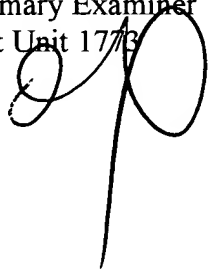
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (703)-308-2379. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (703)-309-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

D. Lawrence Tarazano  
Primary Examiner  
Art Unit 1773



dlt  
October 19, 2003